



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,841	07/25/2003	Perry W. Auger	005127.00247	9271

22907 7590 05/03/2005

BANNER & WITCOFF  
1001 G STREET N W  
SUITE 1100  
WASHINGTON, DC 20001

EXAMINER
----------

KAVANAUGH, JOHN T

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/626,841

**Applicant(s)**

AUGER ET AL.

**Examiner**

Ted Kavanaugh

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-38 is/are allowed.
- 6) ☒ Claim(s) 1-8 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4-8-2005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Drawings***

1. The drawings were received on April 8, 2005. These drawings changes are approved by the examiner.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1,5 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4,574,498 (Norton et al).

Norton teaches an article of footwear comprising a cleat assembly, a midsole (22,34), and an upper (12) bonded to the midsole. The midsole will cushion the bottom of the foot from rocks, pebbles and other ground terrain. The midsole is bonded by a rivet 29 or any other conventional manner as well, see col. 2, lines 62-65. The footwear of Norton lacks a "full-length lasting board" as claimed. Nowhere in the disclosure of Norton does it teach a full length lasting board

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2,4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norton '498.

Norton teaches footwear as claimed except for the midsole being made out of heated and compressed EVA foam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the midsole of Norton out of a EVA foam, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Regarding the foam being heated and compressed, this limitation is a product by process limitation and it is well settled that the patentability of a product ordinarily cannot depend on its method of being made. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (1985). The method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight. Moreover, "Product-by-Process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps", MPEP 2113.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norton as applied to claim 2 above, and further in view of US 4914838 (Ihlenburg).

Ihlenburg teaches an air cushion (20; see col. 3, lines 63-68) used in the heel region between the upper and the midsole (base member 12). It would have been obvious to provide the footwear of Norton with a heel cushion, as taught by Ihlenburg, to provide better cushioning characteristics.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Norton '498 in view of US 6167640 (Schafer).

Norton teaches footwear as claimed except for the upper comprising a peripherally stitched Strobel sock. Norton teaches the upper and the sole attached by rivets (29) or any other conventional manner as well, see col. 2, lines 62-65. Schafer, in the background of the invention, teaches the method known as the Strobel lasting method which involves stitching an insole (sock) to the upper, see col. 1, lines 34-44. It would have been obvious to provide the upper of Norton with a stitched Strobel sock, as taught by Schafer, to provide a more secure structure.

8. Claims 7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norton '498 in view of US 6018891 (Duclos).

Norton teaches footwear as claimed except for the footwear comprising a lining covering the padded collar element (18) and the inside portion of the footwear. Duclos teaches a footwear wherein the footwear comprises a lining (32) covering the padded collar element and the inside portion of the shoe. The lining covers the heel counter and is free of discontinuities in this region; see figure 2. It would have been obvious to provide the footwear of Norton with a lining covering the padded collar and the inside of the footwear, as taught by Duclos, to provide additional comfort to the wearer.

Regarding the padded collar element padded with closed cell foam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the padding out of closed-cell foam, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

*Allowable Subject Matter*

9. Claims 9-38 are allowed.

*Response to Arguments*

10. Applicant's arguments filed April 8, 2005 have been fully considered but they are not persuasive.

Applicant argues that Norton does not teach that these components are cushioning.

In response, what is claimed is "midsole...providing cushioning" and clearly any layer positioned below the foot will provide some degree of cushioning from the ground.

Applicant argues that Norton fails to teach the lack of a full-length lasting board.

In response, it is the lack of the teaching of a full-length lasting board that satisfies the lack of this feature.

*Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

12. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”

-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.


13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (703) 872-9306 (**FORMAL FAXES ONLY**). Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

Application/Control Number: 10/626,841  
Art Unit: 3728

Page 7

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
April 25, 2005



Drawing Changes Approved JK 4/25/05

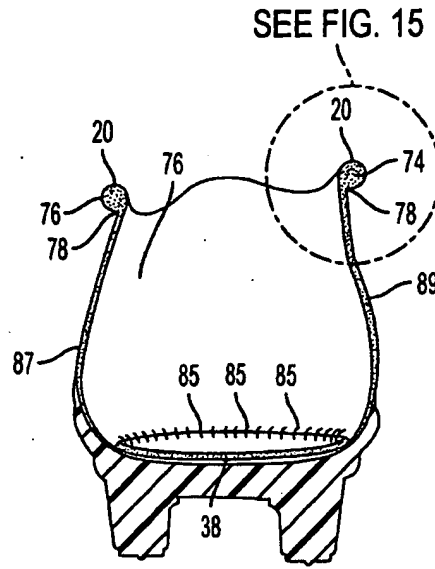


FIG. 14

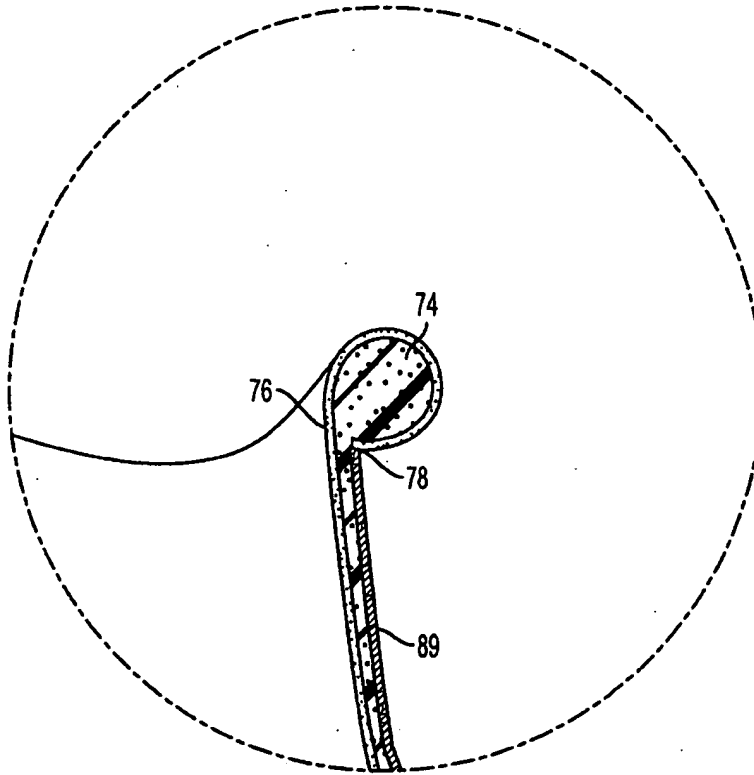


FIG. 15

Appl. No. 10/626,841  
Amtd. Dated April 8, 2005  
Reply to Office action of January 12, 2005  
Replacement Sheet (1 of 1)